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Notice of Allowability

Application No.

10/050,196

Applicant(s)

MONTGOMERY, R. ERIC

Examiner

Frederick F. Krass

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment dated 4-25-05.
2. ☒ The allowed claim(s) is/are 18-37.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>5-5-05</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>1/17/02</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

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Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Mahoney on 5-5-05.

The following changes have been made:

1) In the specification, page 1, second line, immediately after "2001" and immediately before the semicolon there has been inserted --- , now USP 6,536,628 ---

2) In the specification, page 1, third line, immediately after "1999" and immediately before the semicolon there has been inserted --- , now USP 6,322,773 ---

3) In the specification, page 1, fourth line, immediately after "1998" and immediately before the semicolon there has been inserted --- , now USP 6,312,670 ---

4) Nonelected claims 13-17, 38-42 and 49-53 have been canceled without prejudice thereto.

5) Duplicate claims 54-63 have been canceled without prejudice thereto.

6) Claim 18, first line, "the" has been deleted.

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7) Claim 18, third line, immediately before "composition" there has been inserted --- first -
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8) Claim 18, fifth line, "mixture" has been changed to --- tooth bleaching composition ---

9) Claim 18, fifth and sixth lines, "in an amount effective to whiten teeth" has been
deleted.

10) Claim 18, sixth line, "whitening mixture" has been changed to --- tooth bleaching
composition ---

11) Claim 19, last line, "TRIS" has been changed to --- tris(hydroxymethyl)aminomethane

12) Claims 20 and 21, first line of each claim, in each instance immediately before
"composition" there has been inserted --- first ---

13) Claim 21, second line, "in a manner" has been deleted.

14) Claim 23, third line, "Raising" has been changed to --- raising ---

15) Claim 23, third line, "the" has been deleted.

16) Claim 23, fourth line, "tooth surface" has been changed to --- teeth ---

17) Claim 25, last line, "TRIS" has been changed to --- tris(hydroxymethyl)aminomethane

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18) Claim 27, second line, "in a manner" has been deleted.

19) Claim 28, first line, "the" has been deleted.

20) Claim 29, third line, the second occurrence of "the" has been deleted.

21) Claim 29, fifth line, "a mixture comprising" has been deleted.

22) Claim 29, fifth line, "precursor compound" has been replaced by --- releasing ---

23) Claim 29, sixth line, "in an amount effective to whiten teeth" has been replaced by ---
containing tooth bleaching composition ---

24) Claim 29, last line, "whitening mixture" has been changed to --- tooth bleaching
composition ---

25) Claim 30, last line, "TRIS" has been changed to --- tris(hydroxymethyl)aminomethane

26) Claim 31, first line, immediately after "composition" there has been inserted ---
capable of buffering tooth surface pH ---

27) Claim 32, third line, "the" has been deleted.

28) Claim 32, fourth line, "mixture comprising a hydrogen peroxide precursor compound"
has been deleted and replaced by --- peroxide releasing ---

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29) Claim 32, fifth line, "in an amount effective to whiten teeth" has been deleted and replaced by --- containing tooth bleaching composition ---

30) Claim 32, last line, "whitening mixture" has been changed to --- tooth bleaching composition ---

31) Claim 33, penultimate line, "TRIS" has been changed to --- tris(hydroxymethyl)aminomethane ---

32) Claim 35, as a new line between the second and third lines there has been inserted:

--- applying to the teeth a first composition having a pH of between about 7 and about 10,

33) Claim 35, third line, "the" has been deleted.

34) Claim 35, fourth and fifth (original numbering) lines, "mixture comprising a hydrogen peroxide precursor compound or hydrogen peroxide in an amount effective to whiten teeth" has been deleted and replaced by --- peroxide containing or hydrogen peroxide releasing tooth bleaching composition ---

35) Claim 35, last line, "whitening mixture" has been changed to --- tooth bleaching composition ---

36) Claim 36, first and second lines, "the step of maintaining includes applying a" has been deleted and replaced by --- said first ---

37) Claim 36, second line, "including" has been changed to --- includes ---

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38) Claim 36, penultimate line, "TRIS" has been changed to ---
tris(hydroxymethyl)aminomethane ---

39) In the abstract, the first paragraph has been deleted.

40) In the abstract, "Another embodiment of" has been deleted and "the" (as it appears before (present) has been capitalized.

41) Claims 18, 23, 29, 32 and 35, last line of each claim, in each instance "between" has been deleted.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

The claims remain allowable for the reasons provided previously at page 5 of the previous Office Action. Applicant has discovered, quite unexpectedly, that sequentially applying a basic composition, and then a peroxide tooth bleaching composition, substantially reduces the amount of time needed for effective bleaching (to just 15 to 30 minutes, as claimed herein).

The examiner notes that no copending case naming Eric R. Montgomery, including the patented parent cases of the instant application, recites the novel and unobvious feature of sequentially first applying a composition having a pH of about 7 to about 10, followed by applying a peroxide tooth bleaching agent for a period of about 15 to about 30 minutes. For example, USP 6,514,543, USP 6,312,670 and 5,922,307 all recite methods in which the alkalizing agent and peroxide are administered simultaneously, not sequentially, to the tooth surface. They also include additional non-obvious features as well, e.g. a multichamber vessel in the '543 and '670 patents with a single exit (which would make sequential administration impossible), or a calcium chelating agent and very high percentage of water (both of which would be expected to slow, not

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accelerate, bleaching) in the '307 patent. Accordingly, no issues of obviousness-type double patenting are seen to be raised.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick F. Krass whose telephone number is 571-272-0580. The examiner's schedule is as follows:

Monday: 10:30AM- 7PM;
Tuesday: 10:30AM - 7PM;
Wednesday: off;
Thursday: 10:30AM- 7PM; and
Friday: 10:30AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached at 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frederick Krass
Primary Examiner
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